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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,584	05/03/2002	Audrey Goddard	10466/351	2701

30313 7590 04/12/2005

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EXAMINER	
HUNNICUTT, RACHEL KAPUST	

ART UNIT	PAPER NUMBER
1647	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/063,584	**Applicant(s)** GODDARD ET AL.	
	Examiner Rachel K. Hunnicutt	**Art Unit** 1647	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 1-5.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 0305
13. ☒ Other: PTO-892.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments with respect to the rejection of claims 1-5 under 35 U.S.C. 101 have been fully considered but have not been found to persuasive. Applicants refer to Cross v. Iizuka, 753 F.2d 1030, 224 U.S. P.Q. 739 (Fed. Cir. 1985) and argue that successful in vitro testing for a particular pharmacological activity establishes a signicant probability that in vivo teting for this particular pharmacological activity will be successful (p. 6 of the response). Applicants argue that the data in Example 18 is reliable and significant and is more than sufficient to establish a "significant probability" that the differential expression of the PRO1335 nucleic acid in normal stomach, lung, rectal, and skin tissue as compared to stomach, lung, rectal, and melanoma tumors provides diagnostic utility for the claimed antibodies.

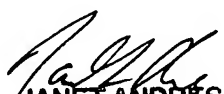
The utility proffered by Applicants is not a substantial utility. Applicants have not taught what kind of lung, stomach, rectal or skin tumors could be diagnosed. Applicants have not taught baseline levels of expression, nor have Applicants provided numerical values for the levels of overexpression and underexpression. Merely stating that the nucleic acid is "more highly expressed" is simply an invitation to experiment. This is distinguishable from Cross v. Iizuka, where the invention at issue was an imidazole derivative compound which inhibited the synthesis of thromboxane synthetase. One skilled in the art would know how to use such a compound. This is contrary to the current situation, where one skilled in the art would not know how to use the claimed invention in the diagnosis of lung, rectal, stomach or skin tumors.

On p. 11 of the response, Applicants argue that there is a direct correlation between mRNA levels and the level of expression of the encoded PRO1335 protein. However, Chen et al. teach that correlation between protein levels and mRNA expression in lung adenocarcinomas varies depending upon the protein (Chen et al. (2002), Mol. Cell. Proteomics 1.4: 304-313). Of 165 protein spots studied, only 17% of the samples showed a statistically significant correlation between mRNA and protein (p. 311). Some of the proteins actually demonstrated a negative correlation with the mRNA expression values (p. 311). Thus, without further testing it cannot be assumed that mRNA levels correlate to protein levels.

A substantial utility, by definition, is a utility that defines "real world" use, and a utility that requires or constitutes carrying out further research to identify or reasonably confirm a "real world" context of use is not a substantial utility. In the instant case, the overexpression of PRO1335 in normal lung, stomach, skin and rectal tissue as compared to lung, skin, rectal, and stomach tumor tissue (if significant), at the most, is an interesting invitation for further research, experimentation and confirmation as to whether PRO1335 is useful as a diagnostic marker. These further research and experimentation, however, is part of the act of invention, and until it has been undertaken, the claimed invention is not considered substantial.

The rejection of claims 1-5 under 35 U.S.C. 112, first paragraph, for lack of enablement due ot the invention not being supported by a specific or substantial asserted utility or a well-established utility, is maintained for reasons of record pn p. 5 of paper no. 1204.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel K. Hunnicutt whose telephone number is (571) 272-0886. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JANET ANDRES
PRIMARY EXAMINER